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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,283	02/15/2002	Makoto Iwayama		9044

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/075,283

Applicant(s)

IWAYAMA ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/23/04, 5/24/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Transitional After Final Practice***

1. Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's Amendment submission after final filed on March 23, 2004 has been entered.

2. Status of the claims: Claims 10-18 are rejected.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 10-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirsch et al. (U.S. Patent No. 6,018,733).

As to claim 10, Kirsch et al. discloses

making a weighted term list from documents resulting from a search of a first document database, the weight of each term reflecting the importance of the term in the first document database, the documents having a high relevance to a first search input to said first document database, and the first search input being a set of keywords, fragments of a document or any desired set of documents (See Kirsch et al. column 4, lines 38-67, and see Kirsch et al. column 5, lines 5-22);

performing a search of a second document database (See Kirsch et al. column 2, lines 44-49);

wherein the search results from said first document database are used to derive a second search input for performing said search of said second document database, and is used as input to search another plural document databases (See Kirsch et al. column 3, lines 24-62);

wherein each term in the documents selected from the search of the second document database is weighted considering the importance of the term both in the first document database and the second document database, and the weight being used to calculate the relevance of the selected documents from the second document database (See Kirsch et al. column 9, lines 9-56, also see Kirsch et al. column 15, lines 10-48, and see Kirsch et al. abstract).

As to claim 11, Kirsch et al. discloses

wherein an interface is provided in which a set of documents from the search result of said selected document database are selected or deselected, and a set of documents selected from the search result are used as an are used in performing the second search input to perform a search on said second document database (See Kirsch et al. column 10, lines 30-38).

As to claims 12, and 14, Kirsch et al. discloses

wherein a summary containing only topic words in the first search input is used to perform the second search (See Kirsch et al. column 10, lines 46-67, wherein “containing only topic words in the first search” reads on “existing base collection”).

As to claims 13, and 15, Kirsch et al. discloses

wherein a client transmits a set of documents in a search input to a server where said first document database is stored, receives a summary comprising only topic words related to the set of documents which is sent, sends a search input corresponding to said summary reflecting a user’s evaluation of the summary to a server where said another document database is stored, and receives the second search result from a search of said second document database is stored, and receives a search result from the search of said document database (See Kirsch et al. column 15, lines 28-63, also see Kirsch et al. column 10, lines 1-28).

As to claim 16, Kirsch et al. discloses

wherein said server produces a summary from topic words relevant to the set of documents sent by the client and transmits it to the client, and searches and transmits a set of

documents having a high relevance to any summary sent by the client, to the client (See Kirsch et al. column 10, lines 46-67).

As to claim 17, Kirsch et al. discloses

wherein said client has an interface for specifying a set of documents for the first search input and document databases to be searched, the set of documents in the search input is sent to a server specified by the user, a summary of the set of documents is received from this server, the summary received is sent to the server comprising said second document database, and search results are received from the search second document database and displayed (See Kirsch et al. column 15, lines 28-63, also see Kirsch et al. column 10, lines 1-28, and see Kirsch et al. column 2, lines 44-49).

As to claim 18, Kirsch et al. discloses a service for searching documents wherein servers comprising document databases and programs to manipulate said databases are dispersed over a network and a client connected to said servers performs a document search (See Kirsch et al. column 2, lines 44-49, also see Kirsch et al. figure 5),

said service providing a document search method in which the client transmits a set of documents in a first search input to one of said servers where a first document database is stored (See Kirsch et al. column 10, lines 46-67, wherein “containing only topic words in the first search” reads on “existing base collection”),

receives a summary comprising only topic words related to the set of documents which is sent (See Kirsch et al. column 10, lines 46-67, wherein “containing only topic words in the first

search” reads on “existing base collection”), send a second search input corresponding to said summary reflecting a user's evaluation of the summary to a server where a second document database is stored (See Kirsch et al. column 15, lines 28-63, also see Kirsch et al. column 10, lines 1-28, and see Kirsch et al. column 2, lines 44-49), and

receives a search result from the search of the second document database, wherein said server storing the first document database produces the summary of topic words relevant to the set of documents sent by the client and transmits the summary to the client, and searches and transmits a set of documents having a high relevance to any desired summary sent by the client, to the client (See Kirsch et al. column 4, lines 42-67, also see Kirsch et al. column 5, lines 23-46).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 10-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Crandall et al. (U.S. Patent No. 6,321,228 B1) teaches first and second database search results and ranking of relevant documents.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
July 27, 2005

  
CHARLES RONES  
PRIMARY EXAMINER